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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,917	03/18/2004	Korry D. Kobel	3638-84	5430

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EXAMINER

THOMPSON, HUGH B

ART UNIT PAPER NUMBER

3634

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,917

Applicant(s)

KOBEL, KORRY D.

Examiner

Hugh B. Thompson II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,11,12 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 2,6-8,10 and 13-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-18-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, drawn to an aerial platform and saw accessory, classified in class 182, subclass 2.1.
- II. Claims 19 and 20, drawn to a method of constructing a vehicle with a wall saw accessory, classified in class 299, subclass 39.3.
- III. Claims 21-23, drawn to a coolant circuit, classified in class 182 subclass 2.9.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process of making can be used to make a hydraulic excavator or motor truck coupled with a cutting or saw accessory.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as supplying hydraulic power to only the platform or a pressure washer. See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and the search required for Groups I and II is not required for Group III, restriction for examination purposes as indicated is proper. During a telephone conversation with Mr. Alan Kagen on April 27, 2005 a provisional election was made with oral traverse to prosecute the invention of groups I and II, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 9, the applicant has failed to provide any structural relationships between the hydraulic power source, the manipulator, the saw accessory or the work platform/vehicle. The applicant has merely listed a catalogue of elements in claim 1. Also, though not an ambiguity per se, the applicant fails to define the structure of the aerial work platform so as to distinguish from any other type of vehicle with lifting features.

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With respect to claims 1-3 and 9-11, the phrase "saw/track" is improper and should be removed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 9, 11, and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Bertrand #4,832,412, in view of Hollifield #4,998,775. Bertrand discloses vehicle and saw assembly comprised of manipulator assembly (hydraulic) 1, 6, which supports track 5 and saw 11 thereon, the saw having 5 degrees of freedom, i.e., rotatable (1 degree), left to right on track 5 (2 degrees), up and down along arm 1 (2 more degrees), and a hydraulic power source as recited in column 2, lines 55-62, vehicle A, fluid supply/tank D, and chassis B, E. Bertrand fails to disclose two tanks, quick connect couplers, and water coolant.

Hollifield teaches the utility of a saw assembly 9 attachable to a truck or other carrier 36, the assembly using recirculated water coolant 30 for the saw stored in housing 25. The use of water coolant allows for a lubricated cutting head thus providing safer use of the saw. Therefore, to one of ordinary skill in the art, it would have been obvious, as a matter of engineering design choice, to provide the assembly of Bertrand with a water coolant as taught by Hollifield so as to allow for a lubricated cooler cutting head thus providing safer use of the saw, and provide two water tanks to have an adequate supply of water for cooling the cutting head.

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Claims 4, 5, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertrand in view of Hollifield as applied to claims 1, 3, 9, 11, and 16-18 above, and further in view of Denys #6,863,062. Denys, as recited in column 5, lines 1-4, teaches the utility of various fittings, valves and the like, i.e., couplers, used to facilitate efficient use of a fluid power system for a portable saw assembly 11. Therefore, to one of ordinary skill in the art, it would have been obvious, as a matter of engineering design choice, to provide the assembly of Bertrand with various fittings, valves and the like, i.e., couplers, used to facilitate efficient use of a fluid power system, as taught by Denys, while producing no new and unexpected results.

Allowable Subject Matter

Claims 2, 6, 10, and 13 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The primary reason for the allowable subject matter of claims 2 and 10, is the inclusion of a telescope assembly secured to the sliding bracket and including a hydraulic lifting arm, and a rotatable track support assembly attached to the lifting arm via a structural link, the track support assembly including holding brackets. For claims 6 and 13, it is the inclusion of a pressure washer system connected to the hydraulic power source. The prior art of record fails to teach or suggest the claimed features absent the applicant's own disclosure.

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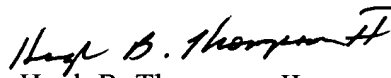
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bertrand #5,230,270, Bieri jun #5,645,040, Bertrand #6,158,817, Kimura et al #6,286,905, and Johnson #4,936,284 are cited to teach saw assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hugh B. Thompson II whose telephone number is (571) 272-6837. The examiner can normally be reached on Monday thru Friday 9 am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on (571) 272-6856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Hugh B. Thompson II
Primary Examiner
Art Unit 3634

April 28, 2005